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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,021	10/02/2003	John Finger	27980/0519156	9925

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EXAMINER	
NORDMEYER, PATRICIA L	
ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

10

Office Action Summary	Application No.	Applicant(s)	
	10/678,021	FINGER, JOHN	
	Examiner	**Art Unit**	
	Patricia L. Nordmeyer	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 18-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 18-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Withdrawn Rejections

1. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

Election/Restrictions

2. Applicant's election of Group I, claims 1 – 14 and 18 – 23 in the reply filed on November 9, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Repeated Rejections

3. The obviousness-type double patenting rejection of claims 1, 2, 4, 5, 7, 18 and 19 over copending Application No. 10/678,020 in the office action dated May 18, 2005 is repeated for reasons previously of record.

New Rejections

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4, 5, 9, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gao et al. (USPN 6,649,318).

Gao et al. disclose a multi-layered laminate construction (Column 9, lines 13 – 14) consisting essentially of a support material having a first surface and second surface(Figure 3, #30; Column 9, lines 23 – 25), wherein the support material may be either paper or polymer chosen from polyolefin, polyester or blends there of, wherein the polyester is selected from polycarbonate and polyethylene terephthalate and wherein the support material is opaque and non-cavitated (Column 9, lines 48 – 58) and the first surface of the support layer is coated with a metal oxide having a first surface of aluminum oxide (Column 13, lines 45 – 48); an active direct thermal layer, having a first and second surface, overlying said first surface of the metal oxide layers, said active direct thermal layer having a chromogenic material (Column 11, lines 38 – 40) for a color developing mechanism reactive to transmissions of heat through either the first or second surface of the active direct thermal layer for forming images within the active direct thermal layer (Figure 3, #26; Column 9, lines 20 – 23) and wherein the first surface of the active direct thermal is covered with a direct thermal top coat layer (Column 9, lines 15 – 17) as in claims 1, 2, 4, 5, 18 and 19. The laminate further comprises one or more color coating layers applied to a binder layer (Column 9, line 47; Figure 3, #28) as in claim 9.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gao et al. (USPN 6,649,318) in view of Zait et al.

Gao et al. disclose a multi-layered laminate construction (Column 9, lines 13 – 14) consisting essentially of a support material having a first surface and second surface(Figure 3, #30; Column 9, lines 23 – 25), wherein the support material may be either paper or polymer chosen from polyolefin, polyester or blends there of, wherein the polyester is selected from polycarbonate and polyethylene terephthalate and wherein the support material is opaque and non-cavitated (Column 9, lines 48 – 58) and the first surface of the support layer is coated with a metal oxide having a first surface of aluminum oxide (Column 13, lines 45 – 48); an active direct thermal layer, having a first and second surface, overlying said first surface of the metal oxide layers, said active direct thermal layer having a chromogenic material (Column 11, lines 38 – 40) for a color developing mechanism reactive to transmissions of heat through either the first or second surface of the active direct thermal layer for forming images within the active direct thermal layer (Figure 3, #26; Column 9, lines 20 – 23) and wherein the first surface of the active direct thermal is covered with a direct thermal top coat layer (Column 9, lines 15 – 17). The laminate further comprises one or more color coating layers applied to a binder layer (Column 9, line 47; Figure 3, #28). However, Gao et al. fail to disclose the metal oxide being a non-stoichiometric aluminum oxide and the image being readable in the near-infrared.

Zait et al. teach a multi-layered laminate construction (Column 1, line 49) comprising a support material having a first surface and second surface, wherein the support material may be either paper or polymer chosen from polyolefin, polyester or blends there of, wherein the polyester is selected from polycarbonate and polyethylene terephthalate and wherein the support material is non-cavitated (Column 2, lines 59 – 65) and the first surface of the support layer is coated with a metal oxide layer of non-stoichiometric aluminum oxide (Column 2, lines 7 – 12); an active direct thermal layer, having a first and second surface, overlying said first surface of the metal oxide layers, said active direct thermal layer having a color developing mechanism reactive to transmissions of heat through either the first or second surface of the active direct thermal layer for forming images within the active direct thermal layer (Column 5, line 36 – the second aluminum layer; Column 5, lines 65 to Column 6, line 3; Column4, lines 43 – 46) and wherein the first surface of the active direct thermal is covered with a direct thermal top coat layer (Column 3, line 62; Figure 1, #18) having a formed image is readable in the near-infrared (Column 5, lines 1 – 3) for the purpose of forming a composite that changes the thermal and optical properties of the object that it is adhered (Column 2, lines 28 – 32).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the non-stoichiometric aluminum oxide in place of the aluminum oxide, which thereby forms a formed image is readable in the near-infrared in Gao et al. in order to form a composite that changes the thermal and optical properties of the object that it is adhered as taught by Zait et al.

8. Claims 7, 8, 20, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gao et al. in view of Zait et al. as applied to claims 3 and 6 above, and further in view of Chang (USPN 5,898,017).

Gao et al., as modified with Zait et al., disclose a multi-layered laminate construction as disclosed above where the formed image is readable in the near-infrared, and the laminate further comprises one or more color coating layers applied to a binder layer. However, the modified Gao et al. fail to disclose that the laminate further comprises a radiation-curable topcoat applied to the top layer of the laminate and a primer layer that is applied to the first surface of the active direct thermal layer.

Chang teaches a laminate comprises a radiation-curable topcoat applied to the top layer of the laminate as a protection coat (Column 2, lines 7 – 8) and a primer layer that is applied to the first surface of the active direct thermal layer (Column 2, lines 45 – 49) in a multicolor chromogenic system in a document having multiply coatings for the purpose of highlighting information and determining authenticity (Column 1, lines 7 – 11).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the radiation-curable topcoat and primer layer in modified

Gao et al. in order to have document having multiply coatings for the purpose of highlighting information and determining authenticity as taught by Chang.

9. Claims 10 – 14 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gao et al. in view of Zait et al. and Chang as applied to claims 7, 8, 20, 21 and 22 above, and further in view of Rochford et al. (USPN 6,755,350).

Gao et al., as modified with Zait et al., disclose a multi-layered laminate construction as disclosed above where the formed image is readable in the near-infrared, and the laminate further comprises one or more color coating layers applied to a binder layer. However, the modified Gao et al. fail to disclose that the laminate further comprises a radiation-curable topcoat applied to the top layer of the laminate, a primer layer that is applied to the first surface of the active direct thermal layer, the laminate further comprises a chemically resistant pressure sensitive adhesive applied to the second surface of the support material with a silicone coated liner laminated to the second surface of the pressure sensitive adhesive, the line release liner being polyester, the label is for use in pathology, hematology and general laboratory uses and the UV-cured chemical resistant barrier topcoat may be applied by flexography, offset, screen-printing or other similar techniques.

Chang teaches a laminate comprises a radiation-curable topcoat applied to the top layer of the laminate as a protection coat (Column 2, lines 7 – 8) and a primer layer that is applied to the first surface of the active direct thermal layer (Column 2, lines 45 – 49) in a multicolor chromogenic system in a document having multiply coatings for the purpose of highlighting information and determining authenticity (Column 1, lines 7 – 11).

Rochford et al. teach a label formed from a laminate that comprises a chemically resistant pressure sensitive adhesive (Column 9, lines 49 – 54) applied to the second surface of the support material with a silicone coated liner laminated to the second surface of the pressure sensitive adhesive, the line release liner being polyester (Column 10, lines 29 – 40) for the purpose of having a label liner with a desirable strength and toughness properties required for efficient transportation of the label in high speed equipment (Column 10, lines 39 – 40).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the radiation-curable topcoat and primer layer in Zait et al. in order to have document having multiply coatings to highlighting information and determining authenticity as taught by Chang along with the release liner in order to have a label liner with a desirable strength and toughness properties required for efficient transportation of the label in high speed equipment as taught by Rochford et al.

With regard to claim 13 where the label is for use in pathology, hematology and general laboratory uses, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

The limitations of the UV-cured chemical resistant barrier topcoat may be applied by flexography, offset, screen-printing or other similar techniques in claim 14 are process limitations. The determination of patentability for a product claim with a process limitation is based on the product itself and not on the method of production. In this case, the limitation of applying a topcoat by flexography, offset, screen-printing or other similar techniques is a method of production and therefore does not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

Response to Arguments

10. Applicant's arguments with respect to claims 1 – 14 and 18 – 23 have been considered but are moot in view of the new ground(s) of rejection. However, since some of the prior art being applied above was used in the previous rejections, the arguments will be responded to below.

In response to Applicant's argument that the argument provided by the Examiner with regard to the combination of Zait et al. and Chang is unclear and circuitous, the Examiner is referring to the fact that it would be obvious to one of ordinary skill in the art to combine the two references as both Chang and Zait et al are directed towards multi-layered composites. Therefore, the addition of the radiation-curable topcoat and primer layer from Chang and into Zait et al would be obvious to one of ordinary skill at the time of the invention since Chang discloses it is known to have a document having multiply coatings to highlighting information and determining authenticity of the formed article.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772
pln

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772
1/3/06